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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,129	05/02/2006	Shigeki Yoneda	13041.1004USWO	4996
52835 7590 05/15/2009 HAMRE, SCHUMANN, MUELLER & LARSON, P.C. P.O. BOX 2902 MINNEAPOLIS, MN 55402-0902				
EXAMINER WALCZAK, DAVID J				
ART UNIT		PAPER NUMBER		
3751				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,129

**Applicant(s)**

YONEDA ET AL.

**Examiner**

David J. Walczak

**Art Unit**

3751

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 28 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-10, 16-27 and 29 is/are rejected.
- 7) ☒ Claim(s) 3, 4 and 11-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date 7/31/06
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Abstract***

The abstract of the disclosure is objected to because a properly drafted abstract should not include phrases that can be implied, such as "The invention provides" (see line 1) or legal phraseology such "said" (see, for example, lines 4, 6, 7, 11, 12 and 16). Further, the abstract should be limited to 150 words. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the coating tool having "oily ink", a "backflow inhibiting material", a "containment tube", a "pen tip" (see claim 24) and "pressure device" (see claim 24) must be shown or the features canceled from the claims. No new matter should be entered.

The Applicant is reminded to include a "brief description" in the specification of any figures added thereto.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure

is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

Claims 22, 23 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 22, an antecedent basis for "The coating tool" (line 1) and "the above mentioned ink containment tube" (lines 3 and 6-7) has not been defined.

In regard to claim 23, an antecedent basis for "The coating tool" (line 1) and "the above mentioned ink containment tube" (lines 2-3) has not been defined. Further, the term "among" (line 5) renders the claim indefinite in that it is unclear as to whether or not the polyvinyl alcohol includes both polyvinyl alcohol and fluorine-bases surfactant or either one of these elements. Further, the language is not clear as to whether or not the

tube is made of polyvinyl alcohol or contacts another element (i.e., the ink) that is formed from polyvinyl alcohol.

In regard to claim 29, the phrase "has in fact antndary" is indefinite in that it is unclear as to what structure this phrases is attempting to define. Further, the term "among" (line 3) renders the claim indefinite in that it is unclear as to whether or not the polyvinyl alcohol includes both polyvinyl alcohol and fluorine-bases surfactant or either one of these elements. Further, the language is not clear as to whether or not the tube is made of polyvinyl alcohol or contacts another element (i.e., the ink) that is formed from polyvinyl alcohol. Lastly, it is unclear as to whether or not the oily ink is intended to be part of the claimed combination. Should the Applicant intend to claim the ink, an antecedent basis for the ink should be defined. Should the Applicant not intend to claim the ink, "adapted to be/for" language should be used when referring thereto.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23 and 29 are, as best understood, rejected under 35 U.S.C. 102(b) as being anticipated by Omatsu et al. (hereinafter Omatsu).

Omatsu discloses a coating tool containing an oily ink 22 in an ink containment tube 21 wherein the tube has boundary that contacts the ink and polyvinyl alcohol is contained in the tube (see column 8, lines 64-65).

Claims 1, 2, 5, 6, 8, 16 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2003-34099 (as cited by Applicant). As noted in the international search report cited by the Applicant on 5/2/06, the '099 reference teaches the claimed structure.

Claims 23 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2003-145985 (as cited by Applicant). As noted in the international search report cited by the Applicant on 5/2/06, the '985 reference teaches the claimed structure.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 9, 10, 17-21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over '099. As discussed in the above mentioned international search report, the claimed structure is considered to be obvious in view of the '099 reference.

9, 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over 985. As discussed in the above mentioned international search report, the claimed structure is considered to be obvious in view of the '985 reference.

#### ***Allowable Subject Matter***

Claims 3, 4 and 11-15 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 22 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claim 28 is allowed.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huson Gregory can be reached on 571-272-4887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
5/14/09

/David J. Walczak/  
Primary Examiner, Art Unit 3751